

REMARKS

A. 35 U.S.C. § 102

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1. Claim 1

In the Office Action of February 6, 2006, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Burkhardt et al. Independent claim 1 states that several angular inclinations of a scanning device in relation to at least one scale are detected and a value for a chronological progression of a change in angular inclination of the scanning device is determined. As described in Applicant's Specification with respect to the embodiments of FIGS. 1-4, an example of angular inclination is the quantity W, the amount of tilting of the scanning device relative scale or measuring direction X. Burkhardt et al. does not disclose either 1) the recited detecting several angular inclinations or 2) determining the recited value for a chronological progression of a change in angular inclination of the scanning device. Accordingly, claim 1 is not anticipated by Burkhardt et al. and so the rejection should be withdrawn.

It is noted that the Office Action asserts at page 2 that Burkhardt et al. discloses “[d]etecting several angular positions of a scanning device” (emphasis added). However, claim 1 refers to detecting several angular inclinations of a scanning device and not several angular positions. The Office Action at page 8 further relies on the following passage as “suggesting an inclination (error) value”:

evaluating unit. The absolute position value of the second reference mark $R2_i$ is superimposed on the absolute position value of the first reference mark $R1_i$ with the correct algebraic sign (+ or -), along with the counting value of the counter. This counting value (Col. 3, ll. 19-23).

The above passage only regards a distance measurement between two positions along the scale. There is no mention of determining an inclination.

Page 8 of the Office Action also takes selected passages from Applicant's own Specification at page 5, lines 6, 7, 13 and 14 as suggesting that the term "inclination" suggests an error value. However, the passages refer to European Application 0 555 507 and not Applicant's invention. Looking at Applicant's description of the embodiment of FIGS. 1-3 of his invention, the angular position W obviously refers to a tilt/inclination of the scanning device 2 with respect to the linear measuring direction X or scale 1. This is consistent with the definition of inclination:

3 a : A deviation from the true vertical or horizontal: SLANT; also
: the degree of such deviation . . . c (1): the angle determined by
two lines or planes (2): the angle made by a line with the x-axis
measured counterclockwise from the positive direction of that axis
Webster's Ninth New Collegiate Dictionary, p. 609 (copy enclosed).

Since the meaning of the term "inclination" is clear and Burkhardt et al. does not disclose detecting several angular inclinations of a scanning device in relation to at least one scale as recited in claim 1. Accordingly, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that Burkhardt et al. does not disclose , determining the recited value for a chronological progression of a change in angular inclination of the scanning device. Since it has been shown that Burkhardt et al. does not disclose detecting the recited angular inclinations, it follows that Burkhardt et al. does not disclose determining a chronological progression of a change in angular inclination. Accordingly, the rejection should be withdrawn.

Despite the improperness of the present invention, claim 1 is being amended to further clarify the nature of the recited term "inclination." This is being done by clarifying that the angular inclination is in relation to a linear measuring direction of at least one linear scale. Since the passage at column 13, lines 19-23 relied on by the Office Action appears to regard the angular measuring device of FIG. 9 and so does not suggest using either a linear scale or a linear

measuring direction, the claims should be deemed patentable over Burkhardt et al.

2. Claims 16-19 and 23

Claims 16-19 and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burkhardt et al. Independent claim 16 states that the first module determines angular inclinations of a scanning device with respect to a measuring direction and the second module determines a value for a chronological progression of several angular inclinations. Burkhardt et al. does not disclose either 1) the recited first module that determines angular inclinations or 2) the recited second module that determines a value for a chronological progression of several angular inclinations for reasons similar to those given above in Section A.1. Accordingly, claim 16 and its dependent claims are not anticipated by Burkhardt et al. and so the rejection should be withdrawn.

Despite the improperness of the present invention, claim 16 is being amended to further clarify the nature of the recited term “inclination.” This is being done by clarifying that the invention regards a linear position measuring system, the angular inclination is in relation to a linear measuring direction of at least one linear scale. Since the passage at column 13, lines 19-23 relied on by the Office Action appears to regard the angular measuring device of FIG. 9 and so does not suggest using either a linear scale or a linear measuring direction, the claims should be deemed patentable over Burkhardt et al.

B. 35 U.S.C. § 103

1. Burkhardt et al. and Hagl et al.

Claim 20 was rejected under 35 U.S.C. § 103 as being obvious in view of Burkhardt et al. and Hagl et al. Claim 20 depends indirectly on claim 16. As mentioned above in Section A.2, Burkhardt et al. does not disclose nor suggest either 1) the recited first module that determines angular inclinations or 2) the recited second module that determines a value for a chronological

progression of several angular inclinations. Hagl et al. does not cure the deficiencies of Burkhardt et al. since Hagl et al. does not suggest altering Burkhardt et al. to have 1) a first module that determines angular inclinations or 2) a second module that determines a value for a chronological progression of several angular inclinations. Furthermore, Hagl et al. does not disclose nor suggest altering Burkhardt et al. to use either a linear scale or a linear measuring direction. Without such suggestion, the rejection should be withdrawn.

It is noted that the Office Action has asserted that the patentability of claim 20 stands or falls with the patentability of claim 16 since the arguments are the same as given with respect to claim 16. This is not the case. The arguments are different. The argument regarding claim 16 regards anticipation while the argument regarding claim 20 regards obviousness for the combination of Burkhardt et al. and Hagl et al. Furthermore, it is not proper to make a rejection based on claims standing or falling together. Such a rejection is only proper in the context of an Appeal. Prior to an Appeal, the Examiner's job is to examine each claim separately and make an independent determination of patentability for each claim.

2. Burkhardt et al. and Schwaiger et al.

Claim 22 was rejected under 35 U.S.C. § 103 as being obvious in view of Burkhardt et al. and Schwaiger et al. Claim 22 depends indirectly on claim 16. As mentioned above in Section A.2, Burkhardt et al. does not disclose nor suggest either 1) the recited first module that determines angular inclinations or 2) the recited second module that determines a value for a chronological progression of several angular inclinations. Schwaiger et al. does not cure the deficiencies of Burkhardt et al. since Schwaiger et al. does not suggest altering Burkhardt et al. to have 1) a first module that determines angular inclinations or 2) a second module that determines a value for a chronological progression of several angular inclinations. Furthermore, Schwaiger et

al. does not disclose nor suggest altering Burkhardt et al. to use either a linear scale or a linear measuring direction. Without such suggestion, the rejection should be withdrawn.

It is noted that the Office Action has asserted that the patentability of claim 22 stands or falls with the patentability of claim 16 since the arguments are the same as given with respect to claim 16. This is not the case. The argument regarding claim 16 regards anticipation while the argument regarding claim 20 regards obviousness for the combination of Burkhardt et al. and Schwaiger et al. Furthermore, it is not proper to make a rejection based on claims standing or falling together.

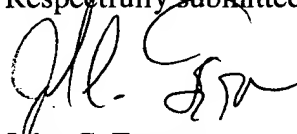
C. Claims 2-15 and 21

Applicant notes with appreciation that claims 2-15 and 21 have been indicated to contain allowable subject matter.

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 1-23 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

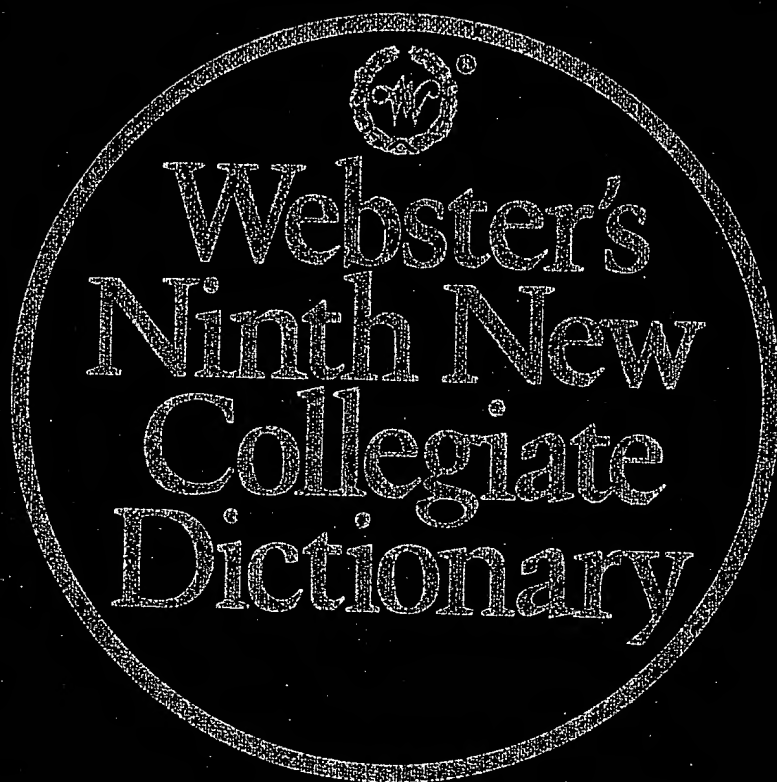
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J.C. Freeman', is written over the typed name.

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